MOTION FILES
FEB 7 1969
LIBRARY
SUPREME COURT, U. S.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 949

KAISER INDUSTRIES CORPORATION,
VEREINIGTE OESTERREICHISCHE EISEN-UND
STAHLWERKE AKTIENGESELLSCHAFT, AND
BRASSERT OXYGEN TECHNIK AG., *Petitioners,*

v.

MCLOUTH STEEL CORPORATION, *Respondent*

MOTION OF THE GOVERNMENT OF AUSTRIA FOR LEAVE TO FILE A BRIEF AMICUS CURIAE IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI AND BRIEF AMICUS CURIAE

DAVID GINSBURG
1700 Pennsylvania Ave., N. W.
Washington, D. C. 20006
Counsel for the Government of Austria

LEE R. MARKS

GINSBURG AND FELDMAN
1700 Pennsylvania Ave., N. W.
Washington, D. C. 20006

CAPLIN & DRYSDALE
1101 17th Street, N. W.
Washington, D. C. 20036
Of Counsel

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 949

KAISER INDUSTRIES CORPORATION,
VEREINIGTE OESTERREICHISCHE EISEN-UND
STAHLWERKE AKTIENGESELLSCHAFT, AND
BRASSERT OXYGEN TECHNIK AG., *Petitioners,*

v.

MCLOUTH STEEL CORPORATION, *Respondent*

MOTION OF THE GOVERNMENT OF AUSTRIA FOR LEAVE TO FILE A BRIEF, AMICUS CURIAE, IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI

The Government of Austria moves this honorable Court for leave to file the attached brief, as *amicus curiae,* in support of the petition for a writ of certiorari

to the United States Court of Appeals for the Sixth Circuit.

In accordance with Rule 42 (1) of the Rules of the Supreme Court, the Government of Austria has sought and obtained the consent of petitioners to the filing of its brief. Consent was requested of respondent, but withheld.

The Government of Austria asks leave to file a brief, *amicus curiae,* in order to present and analyze the issues in this case from its point of view. One petitioner is an Austrian company owned by the Government. Participation by the Austrian Government is appropriate because the decisions below give rise to domestic and foreign policy problems for Austria.

The loss of revenues that would result from the decisions below will be borne in large measure by the Government of Austria and ultimately by the citizens of Austria. The Government of Austria estimates that, of the sums due from users of the invention in this country over the life of the patent, its share (by reason of its ownership of petitioner VOEST) would amount to some $133 million. To one familiar with the United States budget, this sum may not seem large, but it is staggering to the Government of Austria. It represents 4% of the national budget of Austria for 1968, and exceeds Austria's total annual exports to the United States. A loss of this magnitude, even over a period of years, is of major significance to Austria.

Austria, like the United States, is a member of international conventions relating to industrial property rights and hence is interested in the integrity of the international patent system. That system depends, in

large part, upon a rational, fair application of the patent laws of every member of the international patent community. The decisions below, if permitted to stand, will have repercussions extending far beyond the borders of the United States and Austria. They could stimulate a chain reaction of breached agreements, refusals to pay royalties, and litigation throughout the world. There is some indication that this reaction has begun.

Steelmakers of nations throughout the world have paid royalties for the use of the invention in question. Inventions are not accorded patent protection in the USSR; yet the USSR has paid substantial sums for the use of the invention. Only in the United States has the basic patent for the revolutionary L-D steelmaking process even been challenged. The Austrian Government would find it very difficult to explain to its citizens why, for what serious reason, the American steelmaking industry is, as the courts below found, exempt from payments for use of the invention.

The interests of the Austrian Government cannot be adequately presented by the parties, which are business corporations with no responsibilities for the foreign and domestic policy ramifications of the decisions below.

These considerations have led the Government of Austria to question in a brief, *amicus curiae,* the validity of the decisions below. To the Government of Austria it appears that those decisions, based on unnecessary technicalities, reflect an erroneous approach to fundamental questions of patent policy and are at odds with the patent laws previously prevailing in the United States.

For these reasons, it is prayed that the Court grant leave to file the attached brief, *amicus curiae.*

Respectfully submitted,

DAVID GINSBURG
1700 Pennsylvania Ave., N.W.
Washington, D. C. 20006
Counsel for the
Government of Austria

LEE R. MARKS

GINSBURG AND FELDMAN
1700 Pennsylvania Ave., N.W.
Washington, D. C. 20006

CAPLIN & DRYSDALE
1101 17th Street, N.W.
Washington, D. C. 20036

Of Counsel

INDEX

	Page
The Opinions Below	2
Jurisdiction	2
Questions Presented	2
Constitutional Provisions and Statutes Involved	3
Reasons for Granting Certiorari	3
Statement of the Case	5
Argument	10
I. The Approach of the Courts Below Conflicts with Decisions of This Court and Other Circuits and Is Unsupported by the Policies of 35 U.S.C. § 112	10
A. The Decisions	15
B. The Policies Underlying 35 U.S.C. § 112	20
II. "File Wrapper Estoppel" Is Not, on a Correct Analysis, Involved in This Case at All	24
III. Conclusion	27
Appendix	28

CITATIONS

CASES:

Abbott v. Barrentine Mfg. Co., 255 F. Supp. 890 (U.S.D.C. N.D. Miss. 1966)	17
Autogiro Co. of America v. United States, 384 F.2d 391 (Ct. Cl. 1967)	18
Banks v. Chicago Grain Trimmers Ass'n, 88 S. Ct. 1140 (1968)	16
Bridgeford, Application of, 357 F.2d 679 (CCPA 1966)	12
Briggs v. M & J Diesel Locomotive Filter Corp., 342 F.2d 573 (CA 7 1965)	12
Bros Incorporated v. W. E. Grace Mfg. Co., 351 F.2d 208 (CA 5 1965)	17, 19

Page

Bulina, Application of, 362 F.2d 555 (CCPA 1966) ... 18
Canaan Products, Inc. v. Edward Don & Co., 388 F.2d 540 (CA 7 1968) ... 18
Carafas v. LaVallee, 88 S. Ct. 1556 (1968) ... 16
Chicago Pneumatic Tool Co. v. Hughes Tool Co., 97 F.2d 945 (CA 10 1938) ... 17
Chicago Steel Foundry Co. v. Burnside Steel Foundry Co., 132 F.2d 812 (CA 7 1943) ... 21
Conley v. Gibson, 355 U.S. 41 (1957) ... 16
Corning Glass Works v. Anchor Hocking Glass Corp., 374 F.2d 473 (CA 3 1967) ... 22
Corr, Application of, 347 F.2d 578 (CCPA 1965) ... 18
Cutter Laboratories, Inc. v. Lyophile-Cryochem Corp., 179 F.2d 80 (CA 9 1949) ... 17
Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U.S. 428 (1911) ... 11
Edward Valves, Inc. v. Cameron Iron Works, Inc., 286 F.2d 933 (CA 5 1961) ... 26
Farrell Marine Devices, Inc. v. United States, 377 F.2d 560 (Ct. Cl. 1967) ... 18
Foman v. Davis, 371 U.S. 178 (1962) ... 16
General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364 (1938) ... 15
Georgia-Pacific Corp. v. United States Plywood Corp., 258 F.2d 124 (CA 2 1958) ... 18, 20, 21
Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222 (1880) ... 16
Graham v. John Deere Co., 383 U.S. 1 (1966) ... 15, 16, 19
Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271 (1949) ... 16
Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1 (1946) ... 9, 15
Hostettler, Application of, 356 F.2d 562 (CCPA 1966) 18
Huntzicker, In re, 90 F.2d 366 (CCPA 1937) ... 11
Isaacs, Application of, 347 F.2d 887 (CCPA 1965) .. 12
Jones Knitting Corp. v. Morgan, 361 F.2d 451 (CA 3 1966) ... 21
Kemode Mfg. Co. v. United States, 347 F.2d 315 (Ct. Cl. 1965) ... 18
Lehigh Valley R.R. Co. v. Mellon, 104 U.S. 112 (1881) 16
Maty v. Grasselli Chemical Co., 303 U.S. 197 (1938) 16
McClain v. Ortmayer, 141 U.S. 419 (1891) ... 16

Page

McCullough Tool Co. v. Wells Surveys, Inc., 343 F.2d 381 (CA 10 1965) 22, 26
Moon v. Cabot Shoes, Inc., 270 F.2d 539 (CA 9 1959) 17
M.O.S. Corp. v. John I. Haas Co., Inc., 332 F.2d 910 (CA 9 1964) 19
Murray Co. v. Continental Gin Co., 264 F.2d 65 (CA 5 1959) 30
Musher Foundation, Inc. v. Alba Trading Co., Inc., 150 F.2d 885 (1945) 13
Poafpybitty v. Skelly Oil Co., 390 U.S. 365 (1968) .. 16
Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940) 19, 24, 25, 26
Skinner Bros. Belting Co. v. Oil Well Improvements Co., 54 F.2d 896 (CA 10 1931) 17
Smith v. Snow, 294 U.S. 1 (1935) 22
Stuart Oxygen Co. v. Josephian, 162 F.2d 857 (CA 9 1947) 17
Texas Co. v. Anderson-Prichard Refining Co., 122 F.2d 829 (CA 10 1941) 17
Tillotson Mfg. Co. v. Textron, Inc., Homelite, 337 F.2d 833 (CA 6 1964) 23
United Carbon Co. v. Binney & Smith Co., 317 U.S. 228 (1942) 15
United States v. Adams, 383 U.S. 39 (1966) 15, 16, 19, 21, 29
Westinghouse Electric Corp. v. Hanovia Chemical & Mfg. Co., 179 F.2d 293 (CA 3 1949) 18
Whiteman v. Matthews, 216 F.2d 712 (CA 9 1954) .. 17
Wiegand v. W. Bingham Co., 106 F.2d 546 (1939) ..18-19
Yosemite Chemical Co. v. United States, 360 F.2d 948 (Ct. Cl. 1966) 19

OTHER MATERIAL:

35 U.S.C. § 112 ..... 3, 7, 8, 9, 10, 11, 12 13, 14, 15, 16, 19, 20, 21, 23, 24, 25, 26

35 U.S.C. § 282 ..... 24, 28

35 U.S.C. § 103 28

Federal Rules of Civil Procedure § 52(a) 30

Austrian Patent Law of 1950 para. 28 24

Page

Deller's Walker on Patents (2nd ed. 1965) 12

Federico, *Commentary on the New Patent Act*, 35 U.S.C. A. 1, 25 (vol. I 1954) 12

Harris, *Some Aspects of the Underlying Legislative Intent of the Patent Act of 1952*, 23 Geo. Wash. L. Rev. 658 (1955) 24

Note, *Patent Claim Construction and the Halliburton Oil Case*, 15 Geo. Wash. L. Rev. 202 (1947) 16, 23

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 949

KAISER INDUSTRIES CORPORATION,
VEREINIGTE OESTERREICHISCHE EISEN-UND
STAHLWERKE AKTIENGESELLSCHAFT, AND
BRASSERT OXYGEN TECHNIK AG., *Petitioners*,

v.

McLOUTH STEEL CORPORATION, *Respondent*

BRIEF, AMICUS CURIAE, SUBMITTED IN SUPPORT OF A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

The Government of Austria, *amicus curiae*, respectfully urges that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit entered in this case on August 2, 1968.

THE OPINIONS BELOW

The opinion of the United States District Court for the Eastern District of Michigan is reported at 257 F. Supp. 372 (1966). The opinion is reprinted in Appendix A to the petition for a writ of certiorari, at pages 45a-204a. The opinion of the Court of Appeals for the Sixth Circuit is reported at 400 F. 2d 36 (1968). That opinion is reprinted in Appendix A to the petition at pages 1a-43a. Reference in this brief to the opinions below and to other material in the record will be given by citation to the Appendix to the petition.

JURISDICTION

The grounds of jurisdiction are set forth in the petition at page 2 and are adopted by reference here.

QUESTIONS PRESENTED

In 1949, four highly skilled Austrian researchers invented a new steelmaking process. The invention was revolutionary, a giant forward step in making steel. The invention was patentable. Patents for the invention have been issued in numerous countries. In 1957, a patent was issued by the United States Patent Office.

This United States patent was declared invalid in the courts below, not because it lacked intrinsic merit (patentability), but because of asserted deficiencies in drafting the patent itself. The grounds for invalidity were trivial compared with the consequences. They are at odds with the patent law decisions of this and other Courts and with the general trend of this Court's decisions away from unjustifiable technicality in all areas of the law. The ultimate question is:

> Whether it is the public policy of the United States under the patent laws to strike down or

> destroy highly meritorious patentable advances in the arts and sciences because of technical drafting errors even though the invention sought to be covered in the patent is fully and clearly described in the specifications and the file wrapper history of the patent.

Stated more narrowly, the questions presented are:

1. Whether full explanations in the Patent Office dossier pertaining to a patent (the "file wrapper history") can be referred to for purposes of measuring the claims against the requirements of 35 U.S.C. § 112.

2. Whether the doctrine of "file wrapper estoppel" may be invoked against a patentee who alters the wording of his patent application—though *not* the concept or invention—so as to deny him all right to his invention under 35 U.S.C. § 112, even though that invention is defined by the original wording in the specifications and file wrapper history.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

These are set forth in the petition at pages 5-6. We reprint only a portion of the critical statute, 35 U.S.C. § 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

REASONS FOR GRANTING CERTIORARI

This is not an ordinary patent case. The patent in question is basic and has revolutionized the steel industry throughout the world. It was issued by the United

States Patent Office. It is owned by an Austrian company, which is in turn owned by the Government of Austria. The substantial revenues it would produce would benefit Austrian nationals.

The issues are narrow, clear, and legal. Although the physical and chemical questions are complex, the questions before this Court are not. The Court of Appeals did not understand the facts, but our concern here is that it misunderstood and misapplied the law.

The courts below would leave American steel companies free to exploit Austrian technology without compensation to Austria. The immediate impact of the decision would be to encourage other countries to ignore Austrian rights. More important, if, as we believe, the courts below have invalidated the patent through an incorrect approach to the patent laws, the courts of other countries may be encouraged to protect their own industries by treating in similar fashion patents owned by foreign nationals. It is not surprising that courts define and delimit the patent monopoly carefully. But the means of limitation chosen by the lower courts in this case places undue stress on technical rules of drafting to the detriment of important public policies. The case warrants review by this Court.

Moreover, the case falls squarely within the grounds specified in Rule 19 of the Rules of the Supreme Court for granting certiorari.

First, the decision of the Sixth Circuit stands in conflict with applicable decisions of this Court both in patent cases and more generally in a wide variety of cases holding that important rights will not be lost by

reason of unnecessary technicalities (see pp. 15-16, *infra*).

Second, the decision of the Sixth Circuit on the questions presented conflicts with decisions of other Courts of Appeals (see pp. 17-20, *infra*).

Third, the case presents an important question of federal law which has not been settled by this Court (see pp. 20-24, *infra*).

STATEMENT OF THE CASE

Amicus incorporates by reference the statement of the case in petitioner's brief, at pages 7-20. However, some additional background information may be useful.

The invention—the L-D steelmaking process—was patentable. The District Court said so flatly: "the 'new mental concept' of the patentees to avoid a deep penetration of the bath by the jet was a *patentable advance* in the art of steelmaking." (App. A, p. 166a; emphasis supplied.) The Court of Appeals assumed as much (App. A, p. 25a), similarly referring to the discovery as a "patentable advance." (App. A, p. 33a).[1]

---

[1] The Court of Appeals curiously went to great lengths to discuss the issue of obviousness before concluding that "conflicts in the evidence . . . require factual determinations which are best entrusted to the District Court in the first instance, and which the District Court did not make in this case." (App. A, p. 25a). The issue of obviousness is not, at this stage, before the Court.

Nevertheless, *amicus* believes that the intimation in the Court of Appeals' opinion that the invention at issue might fail the obviousness test would, if left unchallenged, prejudice the Court's examination of the issues actually presented. Accordingly, in an appendix to this brief, *amicus* points to some major deficiencies in the Court of Appeals' treatment of the obviousness issue.

Pig iron is iron which contains impurities such as silicon, manganese, carbon, and phosphorus. These impurities must be materially reduced to make steel. The L-D process is a process for removing such impurities from pig iron. Like many pioneer inventions, the L-D process patent appears simple in retrospect. However, the problems it solved had defied solution for decades.

For years prior to discovery of the L-D process, it had been understood that impurities might be removed by blowing a stream of oxygen (or a mixture of oxygen and air) into a bath of molten pig iron. This thought goes back to 1850. As soon as high purity oxygen became available at low cost and in large quantities, many workers tried to use it in various ways to refine iron into steel. None, however, knew how to do it and their efforts failed.

If oxygen were introduced through the bottom of the vessel, the heat produced by the chemical reaction at the vessel bottom would destroy it. This happened in several early experiments. The same problem would arise if the oxygen stream were blown down from above too close to the vessel bottom.

On the other hand, if the oxygen stream were blown deeply into the bath from above—though not so deeply as to destroy the bottom—another difficulty would arise. Phosphorus could not be removed and hence the steel would be unsatisfactory.

Patentees found that it was essential that the oxygen penetrate the bath to a limited extent only; in other words, that it was essential to avoid having the oxygen jet penetrate deeply into the bath. When this is done, the stirring or circulation of the bath is brought about

by the chemical reactions that take place within the bath. All of the prior art workers believed and taught that the stirring or circulation of the bath had to be accomplished by the mechanical or physical action of the jet and that this required deep penetration of the jet. For this reason they all taught deep penetration. What had eluded prior art workers was that the common reliance on mechanical agitation was misplaced. The *chemical* reaction of the oxygen and molten metal —resulting from a metallurgically unforeseeable phenomenon—achieved the necessary result.

The discovery that a stream of oxygen directed only a relatively slight way into the vessel would purify the metal was revolutionary. The new process was without serious flaws. It suffered from none of the deficiencies of too deep penetration of the oxygen jet. It yielded high quality steel about 15 times more rapidly and far cheaper than the process that had previously been in common usage.

A patent for the invention was first sought in the United States in 1951. Amendments and redrafted applications were submitted over the next six years. Finally, in 1957, two weeks after the patent claims had been rewritten and explanatory affidavits filed by two patentees, the Patent Office issued a patent for the L-D process. The prior applications and affidavits were, of course, lodged in the file wrapper, the Patent Office's public dossier for each issued patent, which is available to the public from the moment a patent issues.

The invention was fully, clearly, and concisely described in the specifications (description) as required by 35 U.S.C. § 112. Also in accordance with 35 U.S.C. § 112, the specifications concluded with two claims "particularly pointing out and distinctly claiming the

subject matter" which patentees regarded as their invention.

The principal claim of the issued patent, the only one here in question, reads in relevant part as follows:

> Method of refining molten impure iron . . . which comprises discharging a stream of oxygen vertically downwardly . . . onto and below the surface of the bath at the central portion thereof, *to an extent to avoid material agitation of the bath by the oxygen stream,* the contact of the oxygen with the bath resulting in reaction of the oxygen with a portion of the iron and with the oxidizable impurities of the bath . . . said reaction producing a circulatory movement in the molten metal, which circulatory movement brings those portions of the molten metal bath which are remote from the reaction zone into the reaction zone whereby those portions are subjected to said reaction . . . . [Emphasis supplied.]

This entire case rests upon two determinations of the courts below with respect to this claim:

1. That the claim as a whole and the underscored passage in particular are not sufficiently clear to meet the test of 35 U.S.C. § 112;

2. That patentees cannot rely upon the file wrapper history (in particular two affidavits which clearly explain the invention and the terminology used in the claim) to supply the clarity allegedly lacking in the claim itself.

If the second issue is resolved in favor of petitioners, the first issue becomes irrelevant; the second issue is the only one presented to this Court. The decisions below hold that claims stand or fall on their own wording, regardless of the light shed on them by material in the file

wrapper; this is contrary to the decisions of other Courts of Appeals and to decisions of this Court. Moreover, it runs contrary to the trend of the law in the United States, as articulated by this Court, to the effect that valuable rights will not be made to stand or fall on insignificant and unnecessary technicalities. There is nothing inherent in the nature of patent law or the often complicated factual situations involved in patent cases that requires this trend of the decisions to except patent law. Finally, the decision finds no basis or support in public policy.

The proper test for measuring a patent claim against 35 U.S.C. § 112 is both a narrow, precise legal issue and a crucial one, to which this Court should now direct its attention. The courts, especially the courts below, are apparently confused as to the proper sources of guidance for construing patent claims. The circumstances of this case demonstrate that such confusion can wreak grievous damage. It is inconceivable that the drafters of 35 U.S.C. § 112 contemplated the interpretation which the statute received at the hands of the Sixth Circuit in this case. It is therefore important that this Court, which has not construed 35 U.S.C. § 112 for more than twenty-two years,[2] consider the issue, settle the law, and accord patentees an idea of what they may expect in the courts of the United States.

---

[2] It appears that the last case directly concerned with the interpretation of patent claims with respect to 35 U.S.C. § 112 was *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U.S. 1 (1946).

ARGUMENT

I. THE APPROACH OF THE COURTS BELOW CONFLICTS WITH DECISIONS OF THIS COURT AND OTHER CIRCUITS AND IS UNSUPPORTED BY THE POLICIES OF 35 U.S.C. § 112.

The L-D process patent was obtained only after the patentees had amended their applications several times. The patentees repeatedly emphasized, as the gist of their invention, the "avoidance of [that] deep penetration" which characterized the failures of the prior art. Claims focusing on this characteristic were pending in the Patent Office when the patentees changed the terminology of their claim. In its final form, the claim does not use the phrase "avoidance of deep penetration." Rather, it refers to avoidance of "material agitation," and specifies that the oxygen is blown onto and below the surface of the bath "to an extent [depth] to avoid material agitation of the bath by the oxygen stream."

The specifications of the patent contain numerous references to "avoidance of deep penetration" and adequately define this term. And the affidavits of the patentees, submitted when the wording of the claim was last changed two weeks before the patent issued, make clear that the patentees considered it essential to avoid stirring (agitating) the molten metal by a deeply penetrating oxygen jet;[3] and that if deep penetration were

---

[3] "[O]ur concept of securing purification of the entire contents of the bath mainly by the controlled circulation induced by the reaction center is just the opposite of trying to carry the oxygen to all parts of the bath by agitation produced by deep penetration, as by the methods disclosed in the [most relevant prior art] patents . . . ." Affidavit of patentee Hubert Hauttmann, App. B, p. 230a.

avoided, the problem of excess phosphorus would be avoided as well.[4] These affidavits, in other words, explain fully and clearly the concept of "avoiding material agitation" of the bath by the oxygen stream, and make absolutely clear that that concept, in the minds of the patentees, was the same as the concept of "avoiding deep penetration."[5]

So far as the patentees were concerned, the phrases were synonymous. *The question in this case is whether "avoid material agitation" should be interpreted to mean what the patentees intended it to mean and—in affidavits submitted to the Patent Office—said it meant: "avoidance of deep penetration."* If so, both courts below agreed or assumed that the patent claim is not invalid for failure to satisfy 35 U.S.C. § 112. (App. A, pp. 163a, 25a).

The Court of Appeals described the phrase "avoidance of material agitation" in the claim as "meaning-

---

[4] "[A] deeply penetrating stream creates an uncontrollable turbulence in the bath. . . . Furthermore, the phosphorous cannot be slagged off." Affidavit of patentee Franz Rudolf Rinesch, App. B, p. 224a. It has long been common practice in the Patent Office to take such affidavits of patentees into account in deciding whether to issue a patent. See, *e.g.*, *In re Huntzicker*, 90 F.2d 366, 368 (CCPA 1937).

[5] The record does not disclose the reason for the change in the wording of the claims. It is worth noting that the patentees did not know precisely how the chemically induced circulation of the molten metal came about, or its relationship to mechanical agitation. The fact that patentees may not have understood precisely how their invention worked is, however, irrelevant to the validity of their patent. See, *e.g.*, *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428, 435-36 (1911).

less." (App. A, p. 30a).[6] This is obviously overstatement. When the patentees applied for the L-D process patent,[7] the term meant something to those skilled in the art, to the patentees, and to the Patent Office. It clearly meant something to those skilled in the art because the Miles patent, a leading patent in the prior art, had explicitly indicated that an oxygen jet should penetrate the bath of molten metal deeply in order to obtain (mechanical) agitation of the molten metal.[8]

---

[6] The Court of Appeals stated that "when read in light of the specifications, these claims would not describe a practically negligible penetration to one skilled in the art." (App. A, pp. 30a-31a). The Court derived the term 'practically negligible' from a statement made by attorneys in prosecuting the patent application.

The Court below appears to have been factually wrong in believing that patentees limited their invention to a process involving a "practically negligible" penetration of the oxygen jet. The belief rests on a single statement, extracted from a mass of material in which the attorneys for the patentees were trying to draw a clear line between the invention and the prior art. When the entirety of their submission to the Patent Office is considered, it becomes clear that they never intended—and the Patent Office never required—that the invention be limited to a process with a "negligible penetration" of the jet.

Moreover, the Court was legally wrong in its approach, see n. 14, *infra*.

[7] This is, of course, the relevant time for applying the test of 35 U.S.C. § 112, which refers, not to what the patentee might legally patent, but to "the subject matter which the *applicant regards* as his invention." (Emphasis supplied.) The test is thus to be applied by a court with reference to both the past and the subjective state of mind of the eventual patentee. See, *e.g.*, *Deller's Walker on Patents* § 242 (2d ed. 1965); *Application of Bridgeford*, 357 F. 2d 679, 682 (CCPA 1966); *cf.* Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 25 (vol. 1 1954).

[8] The Court of Appeals correctly noted that the requirement of 35 U.S.C. § 112 that the applicant "particularly [point] out and distinctly [claim] the subject matter" is to be applied with reference to a reader of the claim who is skilled in the relevant art. (App. A, p. 31a). See, *e.g.*, *Deller's Walker on Patents* § 242 (2d ed. 1965); *Application of Isaacs*, 347 F. 2d 887, 892 (CCPA 1965); *Briggs* v. *M & J Diesel Locomotive Filter Corp.*, 342 F. 2d 573, 578 (CA 7 1965).

The term meant something to the patentees, who linked it in the affidavits they submitted to the Patent Office with the term "avoidance of deep penetration." And it meant something to the Patent Office, which issued the patent here in question as soon as an application containing the words "avoidance of material agitation" and affidavits explaining that the term meant "avoidance of deep penetration" were submitted.

To all concerned, the instruction to blow "to an extent to avoid material agitation" was equivalent to: "You are concentrating on the wrong thing when you direct the oxygen jet deeply into the molten metal to stir the metal mechanically."[9] Taken with the remainder of the claim, the phrase meant: "You can penetrate much less deeply and rely on a chemically induced reaction to stir up the bath." It is inconceivable that these explanations of "avoidance of material agitation" were unknown to respondent.[10]

In defending their patent against an attack based on 35 U.S.C. § 112 the patentees are legally and properly

---

[9] The District Court suggested that the concept of a "material agitation" of the molten metal by use of an oxygen jet is highly improbable. (App. A, pp. 177a-185a.) Assuming that the concept is, for modern science, highly improbable, the point is irrelevant. As the foregoing discussion and notes 7 and 8 show, the test of 35 U.S.C. § 112 is to be applied (a) with reference to the time of the filing of a patent application, (b) with reference to the subjective understanding of the patent applicant, and (c) with reference to persons skilled in the relevant art.

[10] The District Court stated that "it is clear from the claims that the language concerning avoidance of material agitation must be read with reference to penetration by the jet . . . ." (App. A, p. 172a). "It is impossible to suppose that anyone who really wished to respect the patent would have any difficulty in identifying what the claim covered." *Musher Foundation, Inc.* v. *Alba Trading Co., Inc.*, 150 F. 2d 885, 889 (CA 2 1945).

entitled to the benefit of the light shed on their claims by the affidavits lodged in the file wrapper of the patent *and available to the public*. The Court of Appeals for the Sixth Circuit concluded, however, that the patentees were not entitled to the benefit of these affidavits:

> Appellants contend . . . that the phrase ["material agitation"] must be given the meaning attributed to it by the patentees as reflected in the affidavits of Dr. Rinesch and Dr. Hauttmann . . . . Appellants would have us . . . [permit] a patentee to give meaning to a meaningless term through affidavits submitted to the Patent Office and filed somewhere obscurely in the file wrapper history of the patent.
>
> The patent law does not require a prospective inventor to search so far in attempting to determine the scope of a patent and the areas left open for inventive inquiry. Section 112 provides that it is the claims that shall *particularly point out* and *distinctly* claim the subject matter of the patentee's invention. Certainly, terms used in the claims can gain meaning from the specifications or from the knowledge attributable to one skilled in the art. But a prospective inventor is required to go no further in attempting to determine the invention claimed and the areas foreclosed to future enterprise. [Emphasis in original.] (App. A, p. 30a)."

[11] Although the Court of Appeals noted that one might resort to specifications and the "knowledge attributable to one skilled in the art" to interpret claims, it did not make proper use of either of these sources of guidance. For example, the Court below apparently failed to take into account the fact that the term "avoidance of deep penetration" appears several times in the specifications—obviously in explanation of the term "avoidance of material agitation" used in the claim. And the Court of Appeals never adverted to the clear connotation which the term "material agitation" had—by reason of the Miles patent, for example—for those skilled in the art: agitation by means of a deeply penetrating jet.

No reasons for the quoted proposition were given and no authority cited. The statement on its face conflicts with the decisions of this Court and of other Circuits. Moreover, the Sixth Circuit's strict rule finds no support in the policies underlying 35 U.S.C. § 112.

A. The Decisions

In *United States* v. *Adams*, 383 U.S. 39 (1966), this Court considered the proper interpretation of patent claims. The Court declared it "fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." 383 U.S. at 49. In interpreting the patent claims there at issue, the Court relied not only on the specifications, but on letters written by the patentee soon after his patent application was filed. The Court concluded that "it is evident that respondents' present reliance upon [a particular] feature was not the afterthought of an astute patent trial lawyer." Statements in *Graham* v. *John Deere Co.*, 383 U.S. 1, 33 (1966) are to the same effect: "It is, of course, well settled that an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office."

The Court has often invalidated patent claims for failure to meet the test of 35 U.S.C. § 112. In such cases, however, it has asked whether the claims, when read in light of available guides to interpretation, are sufficiently clear and distinct to describe the extent of the patent; see, *e.g.*, *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U.S. 1 (1946); *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228 (1942); *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U.S. 364 (1938); or whether the patentee has attempted by a

deliberate choice of imprecise terminology to extend his monopoly beyond the patentable; see, e.g., *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271 (1949); *Lehigh Valley R.R. Co.* v. *Mellon*, 104 U.S. 112 (1881).[12]

The Court appears never to have suggested that the file wrapper history may not be considered, in an inquiry pursuant to 35 U.S.C. § 112, *when that history explains terms used in the claims and is itself as precise and clear as anyone could wish.* Thus, it has never condoned the stringent approach adopted by the courts below in this case. Its most recent decisions, in *Adams* and *John Deere*, require precisely the opposite approach. See also *McClain* v. *Ortmayer*, 141 U.S. 419 (1891); *Goodyear Dental Vulcanite Co.* v. *Davis*, 102 U.S. 222, 227 (1881).

Indeed, the clear trend of the Court's decisions generally points away from the conclusion reached by the courts below here. See, *e.g.*, *Maty* v. *Grasselli Chemical Co.*, 303 U.S. 197 (1938); *Conley* v. *Gibson*, 355 U.S. 41 (1957); *Foman* v. *Davis*, 371 U.S. 178 (1962); *Poultry Hatchery Corp.* v. *Skelly Oil Co.*, 390 U.S. 365 (1968); *Banks* v. *Chicago Grain Trimmers Ass'n*, 88 S. Ct. 1140 (1968); *Carafas* v. *LaVallee*, 88 S. Ct. 1556 (1968). These cases arise, of course, in areas other than the specific one in question here. But the teaching of these and similar cases is that parties will not be stripped of valuable rights on the basis of nice technicalities; that courts should, whenever possible, reach the merits of a case.

---

[12] One writer summarizes the case law interpreting Section 112 as follows: "[I]n the final analysis, the attitude of the courts is that a patent claim must not cover more than the court feels that the patentee is entitled to." Note, *Patent Claim Construction and the Halliburton Oil Case*, 15 Geo. Wash. L. Rev. 202, 207 (1947).

The strict test applied below is contrary to decisions in other Circuits. In *Ross Incorporated* v. *W. E. Grace Mfg. Co.*, 351 F. 2d 208 (1965), for example, the Fifth Circuit declared that "every element of each patent claim is deemed to be material to the inventive concept and, of course, the Patent Office history is relevant if questions arise as to scope of interpretation of claims." 351 F. 2d at 213. See also *Abbott* v. *Baxter-tine Mfg. Co.*, 255 F. Supp. 890, 898 (U.S. D.C. N.D. Miss. 1966). In *Whitman* v. *Mathews*, 216 F. 2d 712 (1954), the Ninth Circuit noted that "the claims are to be interpreted, not only in the light of the specifications and drawings, but also with reference to the file wrapper history." 216 F. 2d at 715. The same Circuit commented in *Cutter Laboratories, Inc.* v. *Lypophile-Cryochem Corp.*, 179 F. 2d 80 (1949) that "[w]hile arguments in the file wrapper cannot be used to expand the scope of claims, they can be used to affirm a construction permissible by the wording of the claims, as according with the intentions of the inventor and the Patent Office." 179 F. 2d at 87. See also *Moon* v. *Cabot Shops, Inc.*, 270 F. 2d 539, 543-44 (CA 9 1959); *Stuart Oxygen Co.* v. *Josephian*, 162 F. 2d 857, 861 (CA 9 1947). And the Tenth Circuit, in *Texas Co.* v. *Anderson-Prichard Refining Corp.*, 122 F. 2d 829 (1941), adopted a similar approach: "Where the language of a patent is susceptible of a particular construction the Patent Office proceedings may be resorted to to determine whether that construction accords with the avowed intent of the parties to the contract [patentee and Patent Office]." 122 F. 2d at 840. See also *Chicago Pneumatic Tool Co.* v. *Hughes Tool Co.*, 97 F. 2d 945, 948 (CA 10 1938); *Skinner Bros. Belting Co.* v. *Oil Well Improvements Co.*, 54 F. 2d 896, 899 (CA 10 1931). Finally, the Court of Claims, in its recent de-

cision in *Autogiro Co. of America* v. *United States*, 384 F. 2d 391 (1967) discoursed at some length on "the necessity for a sensible and systematic approach to claim interpretation": "In deriving the meaning of a claim, we inspect all useful documents and reach what Justice Holmes called the 'felt meaning' of the claim. In seeking this goal, we make use of three parts of the patent: the specification, the drawings, and the file wrapper." 384 F. 2d at 397. See also *Purcell Marine Services, Inc.* v. *United States*, 377 F. 2d 580, 568 71 (Ct. Cl. 1967); *Kemode Mfg. Co.* v. *United States*, 347 F. 2d 315, 319 (Ct. Cl. 1965)."

"There are cases in other courts in which such explicit language is not used but the specifications, the drawings, other material in the file wrapper, or the prior art was consulted for the purpose of interpreting patent claims: e.g., *Caseco Products, Inc.* v. *Edward Don & Co.*, 388 F. 2d 540, 544 (CA 7 1968); *Application of Rubin*, 362 F. 2d 555, 561 (CCPA 1966) (specifications, drawings and affidavits); *Application of Hostettler*, 356 F. 2d 562, 566 67 (CCPA 1966) (affidavits); *Application of Cave*, 347 F. 2d 578, 580 (CCPA 1965) (specification); *Georgia Pacific Corp.* v. *United States Plywood Corp.*, 258 F. 2d 124, 136, 138 (CA 2 1958) (specifications and drawings); *Westinghouse Electric Corp.* v. *Hancock Chemical & Mfg. Co.*, 179 F. 2d 293, 296 97 (CA 3 1949) (specifications and prior art).

The following statement, from the decision of the Sixth Circuit in *Wiegand* v. *W. Bingham Co.*, 106 F. 2d 546 (1939), merits particular note:

> "We are aware that in some jurisdictions reference to file wrapper history to ascertain the meaning of claims is looked upon with disfavor except insofar as it covers the question of estoppel through rejected claims. [Citation omitted.] This is on the ground that it involves looking at preliminary negotiations in the interpretation of a formal document intended to be the final memorial of the parties' intentions. We have not so tightly closed the door to inquiry upon the precise concept of the inventor measured by his own representation. [Citations omitted.] We have noted expanding judicial view [*sic*] in construing private contracts so as best to effectuate the clear intention of the parties . . . [citing Professor Willis-

Some of the cases cited and quoted above do not arise specifically under 35 U.S.C. § 112. *Adams*, for example, focuses on obviousness. *Ross Incorporated* appears to deal chiefly with the doctrine of file wrapper estoppel. Nonetheless, we believe these cases are relevant and in sharp conflict with the decisions below.

If a Court may look to the specifications and letters from the patentee to determine obviousness, as in *Adams*, it should be able to do so for purposes of 35 U.S.C. § 112. A contrary view would mean that a patent upheld as nonobvious on the basis of such interpretive guides would have to be invalidated under 35 U.S.C. § 112. The same point can be made with respect to the file wrapper estoppel cases."

> tion, 3 Contracts, 1780) "The question the court is seeking to answer is the meaning of the writing at the time and place where the contract was made." Conceding that extrinsic aid to construction must be accepted with caution, yet where in the difficult art of claim draftsmanship terms employed in effort to avoid prior art [sic] are susceptible of construction transcending the clear limits of the inventive concept, there should be no more reluctance to search for precise meaning than in a private contract." 106 F. 2d at 548.

In light of the decisions below, it would appear that the door which the Sixth Circuit was not yet quite closing in 1939 has now been definitively shut.

" The proper remedy in a file wrapper estoppel case is to limit a claim to those concepts which the patentee is not estopped to assert, not *automatically* to declare the claim invalid. See, e.g., *Graham* v. *John Deere Co.*, 383 U.S. 1, 33 (1966); *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 220-23 (1940); *Yosemite Chemical Co.* v. *United States*, 360 F. 2d 948, 953-54 (Ct. Cl. 1966); *M.O.S. Corp.* v. *John I. Haas Co., Inc.*, 332 F. 2d 910, 912-15 (CA 9 1964). Once the claim is thus limited, it is absurd to strike it down because, on its face, it fails to "distinctly [claim] the subject matter." Of course the claims on their face do not "distinctly claim" the subject matter in a file wrapper estoppel case; the fact that they claim more than the subject matter is what file wrapper estoppel is all about.

If it is proper to look to specifications and the file wrapper history to determine the *extent of the invention*, it must be proper to look to those materials to ascertain the *meaning of the claim*. Thus, all of the statements of the Circuits quoted above are in direct conflict with the instant decision of the Sixth Circuit, which held that relevant portions of the file wrapper history—affidavits, in particular—could not be relied on to clarify patent claims for purposes of 35 U.S.C. § 112.

B. The Policies Underlying 35 U.S.C. § 112

There is a further consideration in this case at least as important as the conflict among the Circuits. To the Sixth Circuit's statement that "a prospective inventor is required to go no further [than the specifications and the prior art] in attempting to determine the invention claimed and the areas foreclosed to future enterprise" the obvious question is: Why not? There appears to be no good reason, statutory or otherwise, for limiting the sources of explanation of patent claims to the claims themselves, the specifications, and knowledge attributable to one skilled in the art. And there is no policy justification for invalidating patent claims which are clearly explained in other material in the file wrapper, especially when such an important patent is at stake.

Two primary policies behind 35 U.S.C. § 112 are cogently summarized in *Georgia-Pacific Corp.* v. *United States Plywood Corp.*, 258 F. 2d 124, 136 (CA 2 1958): "those skilled in the art must be able to understand and apply the teachings of the invention and enterprise and experimentation must not be discouraged by the creation of an area of uncertainty as to the scope

of the invention." See also *Jones Knitting Corp. v. Morgan*, 361 F. 2d 451, 454 (C.A. 3 1966). In *Chicago Steel Foundry Co. v. Riverside Steel Foundry Co.*, 132 F. 2d 812, 814-15 (C.A. 7 1943), the point is added that the patentee must "make his invention clear, and do so in such a way that his counsel cannot give a different meaning to his words before the Patent Office than he does before the courts." (See the reference in *Adams*, *supra* p. 15, to the "afterthought of an astute patent trial lawyer.")

None of these policies is served by the stringent decision of the Court of Appeals below. The policy of preventing a patentee from extending his patent monopoly in the courts after his patent issues does not require that affidavits in the file wrapper be ignored in interpreting claims. The two affidavits in this case were apparently instrumental in convincing the Patent Office to issue the patent; they should be primary source material for interpreting the claims. The patentee has no way to use them to broaden his patent monopoly.

Nor do the policies announced in *Georgia-Pacific* dictate that the affidavits be ignored. That case does not consider what sources may be consulted to establish the necessary clarity of patent claims. The approach adopted by the Court of Appeals in the instant case, ostensibly permitting resort in the 35 U.S.C. § 112 inquiry to "the specifications or . . . knowledge attributable to one skilled in the art" but not to affidavits in the file wrapper history, finds no support in *Georgia-Pacific*. The prior art knowledge imputed to patent researchers, see n. 8, *supra*, may be more difficult to obtain than material clearly set forth in the file wrap-

per. Moreover, those researching the true meaning of a patent—persons skilled in the art—presumably do research the entire file wrapper because any limitation they find there to restrict the claims accrues to their benefit by reason of file wrapper estoppel. See page 24, *infra*.

Further, even if patent researchers did not always search the file wrapper, the result in this case cannot be justified. Valuable, meritorious patent rights should not be invalidated on the basis of a policy designed to avoid inconvenience to patent researchers. Nothing in the statute or case law requires so draconian a remedy for so negligible a fault. The result is particularly incongruous here since the patentees rely on their affidavits, not to broaden or narrow their claims, but simply to interpret them. As the Sixth Circuit would have it, when a patentee states claims too broadly (the file wrapper estoppel cases) his claims are narrowed but not invalidated; when a patentee explains his claims through material in the file wrapper, he suffers total forfeiture.

Finally, the courts below failed to consider two crucial points, which have always been relied upon by courts interpreting patent claims. First, the I-D process patent was a pioneer patent (App. A, p. 202a) and as such qualified for the most liberal interpretation. See *e.g.*, *Smith* v. *Snow*, 294 U.S. 1, 14 (1935); *Corning Glass Works* v. *Anchor Hocking Glass Corp.*, 374 F. 2d 473, 476 (CA 3 1967); *McCullough Tool Co.* v. *Wells Surveys, Inc.*, 343 F. 2d 381, 401 (CA 10 1965). The rules of construction to be applied to such a patent are different from those applied to a patent in a

crowded field. See, e.g., *Gillette Mfg. Co. v. Textron, Inc., Homedite*, 337 F. 2d 833, 838 (C.A. 6 1964); Note, *Patent Claim Construction and the Halliburton Oil Case*, 15 Geo. Wash. L. Rev., 202, 206 (1947). The Court of Appeals failed even to advert to this distinction.

Second, the courts below failed to consider the obvious reason why the patent claims were framed as they were and the meaning they held for the steel industry. The record below and the file wrapper history of the L-D process patent make clear that the patentees and the Patent Office thought that the invention could be fully and clearly described by reference to "avoidance of material agitation." If there was ambiguity, it was corrected by the explanation in affidavits submitted to the Patent Office. Those affidavits show clearly both that the "ambiguity" in the claim was not an attempt to broaden the scope of the patentees' monopoly, and that the "ambiguity" was anything but ambiguous to patentees, to the Patent Office, and to persons skilled in the steelmaking art, such as respondent. Yet the courts below did not take these considerations into account. They treated the patentees as though they had deliberately tried to extend their patent monopoly and cast aside the patent claim as "meaningless."

The courts below did not apply 35 U.S.C. § 112 with a view to the policies behind that section and according to the rules which this and other courts have established to differentiate the more revolutionary and meritorious patents from others. The result was a mechanical, in-

sensitive, and unjustifiably harsh application of the statute.[15]

II. "FILE WRAPPER ESTOPPEL" IS NOT, ON A CORRECT ANALYSIS, INVOLVED IN THIS CASE AT ALL.

The nonstatutory doctrine known as file wrapper estoppel is succinctly summarized in the opinion of this Court in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940):

> It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. [Citations omitted]. The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. [Citations omitted]. The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. [Citation omitted.]

The Court of Appeals referred to *Schriber* nine times in its discussion of file wrapper estoppel and proclaimed

---

[15] We note, first, that the courts below did not even discuss the presumption of validity of issued patents, see 35 U.S.C. § 282, in their discussions of Section 112, and, second, that the laws of other nations, which require clarity and specificity in applications for patents, do not even permit a challenge to a patent, once issued, on the ground of lack of clarity or specificity. See, *e.g.*, Austrian Patent Law of 1950, para. 28; Harris, *Some Aspects of the Underlying Legislative Interest of the Patent Act of 1952*, 23 Geo. Wash. L. Rev. 658, 685 n. 134 (1955).

its agreement (Judge Edwards dissenting) with the District Court's conclusion that "*Schriber Co.* controlled the result concerning file wrapper estoppel." (App. A, p. 43a)

However, the reasoning by which the courts below reached this conclusion casts serious doubt on their understanding of both *Schriber* and the file wrapper estoppel doctrine. *Amicus* submits that file wrapper estoppel is not involved in this case.

The courts below, predetermining that the invention inhered in the phrase "avoidance of deep penetration," reasoned as follows: 1) the phrase had been present in certain claims submitted to the Patent Office, some of which that office rejected and others of which it did not act upon; 2) the claims of the patent as issued did not contain the phrase; 3) petitioners were therefore estopped to assert that the claims of the patent as issued cover the concept of "avoidance of deep penetration."

This reasoning adds nothing to the lower courts' discussion of the first issue, regarding 35 U.S.C. § 112, because both the specifications and the affidavits of patentees in the file wrapper refer, over and over again, to "avoidance of deep penetration." Indeed, as previously stated, the affidavits contain a full explanation of the relationship of the terms used in the claim of the issued patent and the term "avoidance of deep penetration." If, as *amicus* has urged above, the specifications and file wrapper history must be examined for the light they shed upon the claims, the term "avoidance of deep penetration" cannot possibly be deemed to have been abandoned or rejected. If there was no

abandonment or rejection, of course, there cannot have been an "elimination" within the meaning of *Schriber*.

More important, the reference in *Schriber* to cancelled or rejected "claims" simply cannot be a reference to a particular phrase or turn of words. See, *e.g.*, *McCullough Tool Co.* v. *Wells Surveys, Inc.*, 343 F. 2d 381, 403 (CA 10 1965). The file wrapper estoppel doctrine must refer to abandonment of concepts.[16] The doctrine is designed to ensure that patent protection extends only to what the patentee has claimed, no more and no less. The issue in this case, however, is not whether the claims as issued may be broadened or narrowed by reference to the specifications and file wrapper history but whether they may be clarified and interpreted by such a reference (in which case they describe a patentable invention).

It serves no purpose to proclaim that the sole patentable advance inheres in a certain phrase and then to decide that, because that phrase is not used in the claims, the patentee is estopped to point to the phrase by way of clarification. Such a conclusion could properly be reached only if the phrase, as used in the specifications and file wrapper history, described a concept different from the concept described by the claims. However, as this brief's discussion of the section 112 issue makes clear, all persons concerned—those skilled in the art of making steel, the patentees, and the Patent Office—believed at the time the patent for the L-D process issued that the two concepts were one and the same.

---

[16] Subject matter." See *e.g.*, *Edward Valves, Inc.* v. *Cameron Iron Works, Inc.*, 286 F. 2d 933, 943 (CA 5 1961).

Thus, the file wrapper estoppel issue in this case adds nothing whatever to the issue regarding the proper interpretation of patent claims. To the extent that the file wrapper estoppel issue emerges as the independent question of estopping a patentee to rely on a given turn of words, without regard to the meaning of those words, the decisions of the courts below would appear to be misdirected.

III. CONCLUSION

For the foregoing reasons, *amicus* respectfully requests that the petition for certiorari be granted.

Respectfully submitted,

DAVID GINSBURG
1700 Pennsylvania Ave., N.W.
Washington, D. C. 20006
Counsel for the
Government of Austria

LEE R. MARKS

GINSBURG AND FELDMAN
1700 Pennsylvania Ave., N.W.
Washington, D. C. 20006

CAPLIN & DRYSDALE
1101 17th Street, N.W.
Washington, D. C. 20036

Of Counsel

APPENDIX

Under 35 U.S.C. § 103, a patent may not be granted if the improvement that it represents over prior art would have been "obvious" to "a person having ordinary skill in the art." On the other hand, 35 U.S.C. § 282 states explicitly that an issued patent "shall be presumed valid." The effect of these two sections, taken together, is that a party who is challenging an issued patent as obvious must rebut a presumption that it is nonobvious.

The Court of Appeals eliminated the presumption of validity of the patent at issue by ruling that the prior art Schwarz patent had not been considered by the Patent Office. (App. A, pp. 12a-13a). This ruling is demonstrably erroneous. The Schwarz patent was referred to by name in the amendment of the patent application of June 11, 1957, and an argument against its pertinence was submitted (App. B, pp. 214a-218a). Moreover, it was referred to in the affidavits of patentees Rinesch and Hauttmann. Those affidavits were submitted to the Patent Office for the specific purpose of distinguishing the amended claims that were filed simultaneously with the affidavits from the most relevant prior art patents (Schwarz and Miles). (See App. B, pp. 219a-230a).

To hold, as the Court of Appeals has, that these affidavits were "off-hand" (App. A, p. 13a, n. 6) and thus ineffective to bring their contents to the attention of the Patent Office, merely because they were submitted only two weeks before the issuance of the patent, is clearly wrong. The affidavits were filed concurrently with the amended claims—the claims which are the crux of the patent that finally issued. To conclude, while thus discounting the basic support of the amended claims, that the changed language of the amended claims is so significant as to bring into play the doctrine of file wrapper estoppel against the patentees (see pages 24-27, *supra*) is so inconsistent as to be unfair. Yet that is precisely what the Court of Appeals has done here.

This is only one of several shortcomings in the Court of Appeals' discussion of obviousness. In holding that the patent at issue was not obvious in light of the Schwarz and Miles patents, the District Court found that the Schwarz and Miles patents were inoperable. (App. A, p. 73a, *et seq.*; p. 83a *et seq.*). This finding is vitally important because "an *inoperable invention* or one which fails to achieve its intended result does not negative novelty." *United States* v. *Adams*, 383 U.S. 39, 50 (1966). The Court of Appeals, however, flatly rejected this finding of the District Court. (App. A, pp. 17a-18a). In doing so, it rejected the results of certain unsuccessful experiments performed on the basis of the prior art patents. Because those experiments had been unsuccessful, the Court of Appeals concluded that they had not followed the teaching of Schwarz and Miles and, hence, had not demonstrated them to be inoperable. (App. A, pp. 17a-18a, n. 8). The weakness of this reasoning is that it assumes that what Schwarz and Miles taught was the equivalent of what could be done by following their teaching.

The experiments in question were carried on by Drs. Durrer and Hellbruegge. Respondent called these two men as witnesses in an effort to show that they and not the patentees were the actual inventors of the L-D process. In his testimony, Dr. Durrer claimed that the Schwarz patent "contained his ideas." (App. A, p. 120a). Although the District Court made no specific finding to the effect that Dr. Durrer was the originator of the ideas contained in the Schwarz patent, the District Court did conclude, and respondent conceded, that Drs. Durrer and Hellbruegge were practising the teachings of the Schwarz and Miles patents in their experiments. (App. A, p. 119a). No evidence was presented by respondent in this case to show that satisfactory results had ever been obtained by following either the Schwarz or the Miles patent. On the contrary the testimony of respondent's own witnesses shows that these patents were in fact inoperable.

These failures on the part of experts utilized as witnesses by the respondent, coupled with the absence of any other evidence that other steelmakers were able successfully to practice the teachings of the Miles and Schwarz patents, provide substantial evidence in support of the District Court's conclusion that the Schwarz and Miles patents were inoperable.[17]

The Court of Appeals had no evidence before it to show the operability of the prior art patents and hence, under Rule 52(a) of the Federal Rules of Civil Procedure, had no basis for rejecting the trial judge's findings of fact as "clearly erroneous." The Court of Appeals' failure to observe the standards laid down by Rule 52 for review of lower court findings compounds the error of its refusal to apply the presumption of validity provided by section 282. The result was that the Court of Appeals created, in effect, a presumption of *invalidity* for the patent involved in the present suit, a presumption wholly at variance with both the statute, 35 U.S.C. §§ 103, 282, and the case law interpreting the statute. See, *e.g.*, *Murray Co.* v. *Continental Gin Co.*, 264 F. 2d 65, 69 (CA 5 1959).

The Court of Appeals initiated its discussion of obviousness with a disclaimer of "familiarity" with the steelmaking art. (App. A, p. 9a). That disclaimer, in conjunction with the foregoing summary of major errors in the Court of Appeals' discussion of the issue, should counsel caution in any examination of that discussion.

---

[17] The undisputed evidence also shows that when the patentees tried to follow Durrer, Hellbruegge, Schwarz, Miles, they failed to make satisfactory steel and never did succeed in making satisfactory steel until discovering their new concept.